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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SU, EMILE				
ART UNIT		PAPER NUMBER		
3685				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/556,729

Applicant(s)

KIKKOJI ET AL.

Examiner

EMILE SU

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is in response to communications filed on June 22, 2009. Claims 1-7 and 11-14 are amended. Claims 9 and 10 are withdrawn.
2. **Claims 1-8 and 11-14** are currently pending and are rejected.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2009 has been entered.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a certified English translation of the foreign application is required. MPEP §201.14.

Response to Arguments

6. Applicant's arguments filed March 19, 2009 have been fully considered but they are not persuasive.

Applicant is of the first opinion that Office Action acknowledges that prior art does not disclose relating information (Applicant Remarks, p. 11). Examiner respectfully disagrees. Specifically, page 8 of Office Action mailed February 13, 2009 states "Poltorak also discloses the user of input device to control operation (i.e. input device, see Poltorak, Column 14, Lines 3-9), but does not specifically input recording request" and does not discuss the newly amended language of relating information.

Applicant is of the second opinion that the prior art does not teach "relating information" feature (Applicant Remarks, p. 11). Examiner respectfully disagrees. Specifically, the Poltorak reference(s) teaches storing content and content related information, see Poltorak, Column 13, Lines 3-21; also see Column 16, Lines 52-61 and Column 20, Lines 16-32. The different pieces of information are related to each as they are stored in the same memory. Therefore, the originally cited prior art continues to read on the claimed method and system.

The following assertions of fact have gone unchallenged and are considered admitted prior art- storing different amounts of content in a memory

Claim Objections

7. **Claims 8** is objected to because of the following informalities:

In Claim 8, Applicant marked changes to the fifth and seventh line adding the term "first". However, the term was presented in previous version of the claims (i.e.

claims entered on February 6, 2009). Claim 8 will be examined with the term included as previously presented. Applicant is required to confirm that no new amendments were been made to the claims and appropriately identify the claim accordingly.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-8 and 12-13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Concerning Claim 1, Applicant recites “receiver”, “memory unit” and “memory” in the limitations. These terms are known to be only software components (see IEEE, “The Authoritative Dictionary of IEEE Standards Terms”, seventh edition, pp. 204, 684, 934, 1112, 1234, and 1235). Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. *See In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things”. They are neither computer components nor statutory processes, as they

are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. See *In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. The subject matter of Claim 1, as claimed, is descriptive material per se and hence nonstatutory.

As to Claims 2-4 and 12, see discussion of Claim 1 above. These depending claims inherit and repeat the same U.S.C. §101 deficiency as Claim 1 and are rejected in the like manner above.

Concerning Claim 5, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a “process” under 35 U.S.C. §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the

claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 5 fails prong (1) because there is no specific tie to machine or structure for performing the steps. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

As to Claims 6-8 and 13, see discussion of Claim 5 above. These depending claims inherit and repeat the same U.S.C. §101 deficiency as Claim 5 and are rejected in the like manner above.

Claim Rejections - 35 USC § 112, First Paragraph

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 2, 3, 6 and 7** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Concerning Claims 2 and 6, Applicant amended the claims to recite “at specific time intervals in a buffer”. There is no support found in the disclosure to convey Applicant had possession of altering time intervals of a buffer.

Concerning Claims 3 and 7, Applicant amended the claims to recite “recording different amount of first contents in the buffer”. The most relevant disclosure is found on Pages 9 and 12 of the original Specification. However, there is no support for recording different amount of content as the disclosure only describes storing different time periods. There is insufficient support to convey Applicant had possession of changing the amount of content stored in a buffer.

Claim Rejections - 35 USC § 112, Second Paragraph

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 4 and 8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 4, Applicant recites “the first contents-related information received from the server” and the limitations are unclear because Claim1, from which Claim 4, for example, depends, is silent as to the correlation of “first contents” and “first contents related information” in regard to the server. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. **Claims 1, 5, 12, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak, U.S. Patent No. 7,164,882 B2 (hereinafter Poltorak) in view of Levy et al., U.S. Patent No. 6,505,160 B1 (hereinafter Levy).

With respect to Claims 1, 5, 12 and 13, Poltorak discloses:

a receiver configured to receive first contents (see Poltorak, Abstract; also see Column 16, Lines 52-61 and Column 20, Lines 16-32) from a broadcasting station (see Poltorak, Column 2, Line 62 through Column 3, Line 3) and to receive an input purchase request (see Poltorak, Column 14, Lines 3-9; also see Column 17, Line 57 through Column 18, Line 9);

a temporary memory unit configured to temporarily store first contents-related information related to the first contents (see Poltorak, Column 13, Lines 3-21; also see Column 16, Line 63 through Column 17, Line 2);

a memory configured to store (see Poltorak, Column 13, Lines 22-24) and to relate, the first contents and the first contents-related information (see Poltorak, Column 13, Lines 3-21); and

the memory being configured to store a selection of contents and a selection of contents-related information received from a server, the second contents-related information being related to the first contents (see Poltorak, Column 16, Lines 52-61; also see Column 13, Lines 3-24 and Column 20, Lines 16-32).

Poltorak does not specifically disclose a plurality of second contents and a plurality of second contents-related information. However, it has been held that mere duplication of parts has no patentable significance unless new and unexpected result is produced (*In re Harza*, 124 USPQ 378 (CCPA 1960)). The limitations “a plurality of second contents and a plurality of second contents-related information received from a server” are not given patentable weight for the purpose of prior art examination.

Poltorak does not specifically disclose input recording request. However, Poltorak does teach the use of input device to input a purchase request (see Poltorak, Column 14, Lines 3-9; also see Column 17, Line 57 through Column 18, Line 9) and Levy does teach a user activated recording request (see Levy, Column 14, Lines 43-58; also see Column 14, Line 34 through Column 15, Line 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Levy to create a recording apparatus that records and relates contents-related and broadcast information in response to an input, because the manual input of recording request increases user control over the recorded content.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations following “configured to ...” are not given patentable weight for the purpose of prior art examination.

Further, it has been held that stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cri. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01. The limitations “to relate, based on having a receipt of the input recording request, the first contents and the first contents-related information” and “the second contents-related information being related to the first contents” are not given patentable weight for the purpose of prior art examination.

18. **Claims 2, 3, 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, and further in view of Fiedler, U.S. Patent No. 6,205,419 B1 (hereinafter Fiedler).

As to Claims 2 and 6, Poltorak and Levy disclose the invention substantially as claimed. Poltorak further discloses:

a broadcast information recording unit configured to record the first contents and to record the first contents before and after the input recording request (see Poltorak, Column 12, Line 58 through Column 13, Line 2; also see Column 13, Lines 22-24). Poltorak and Levy do not specifically teach one to use circular buffer design to store information. Fiedler does discuss the use of circular buffer to record audio information before and after a request to record (see Fiedler, Column 3, Lines 31-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to use circular buffer suggested by Fiedler in the recording apparatus of Poltorak to record information before and after a recording request, because circular buffer allows for more efficient operation by calculating only the necessary memory blocks.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations following “configured to ...” are not given patentable weight for the purpose of prior art examination.

As to Claims 3 and 7, Poltorak, Levy, and Fiedler disclose the invention substantially as claimed. Poltorak does not specifically teach one to use different buffer size. Examiner takes Official Notice that storing different amounts of content in a

memory is old and well known in the art (e.g. mixing a personal cassette tape). It would have been obvious to one of ordinary skill in the art at the time of the invention to recording different amount of content in a buffer, because this efficiently utilizes the buffer size.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations “to include recording different amounts of first contents in the buffer” are not given patentable weight for the purpose of prior art examination.

19. **Claims 4 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, and further in view of Kim et al., U.S. Patent No. 6,912,431 B2 (hereinafter Kim).

With respect to Claims 4 and 8, Poltorak and Levy disclose the invention substantially as claimed. Poltorak further discloses the contents are correlated with the contents-related information (see Poltorak, Column 17, Line 58 through Column 18, Line 9). Poltorak does not specifically disclose a sound information synthesizing unit configured to synthesize sound information with the contents being received at a time when the recording request is input. Kim does teach a sound information synthesizing unit configured to synthesize sound information with the contents being received (see Kim, Column 3, Lines 25-50) at a time when the recording request is input (see Column 6, Lines 6-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to add a sound output taught by Kim to a recording apparatus disclosed by

Poltorak to notify the current state of the apparatus, because this provides audio feedback about the current operation.

Further, it has been held that manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself (*In re Casey*, 152 USPQ 235 (CCPA 1967); MPEP 2106 II C). The limitations following “wherein ...” are not given patentable weight for the purpose of prior art examination. Additionally, the language “when the recording request is input...” is also not given patentable weight (MPEP 2106 II C).

20. **Claims 11 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claim 1 and 5 above, and further in view of Danneels et al. (U.S. Patent No. 6,272,472; hereinafter Danneels).

With respect to Claims 11 and 14, Poltorak and Levy disclose the invention substantially as claimed. See the discussion of Claims 1 and 5 above. Poltorak and Levy do not explicitly teach providing all the executable instructions on a computer-readable medium. Danneels teaches a computer-implemented method realized as one or more programs on a computer (see Danneels, Column 2, Lines 40-46). In addition, Danneels teaches that the programs are storable on a computer-readable medium such as a floppy disk or a CD-ROM (see Danneels, Column 2, Lines 46-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Poltorak in view of Levy discussed in Claims 1 and 5. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of

distribution and installation and execution of the software on another computer (see Danneels, Column 2, Lines 46-49).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miayke, U.S. Patent No. 6,038,434. Prior art discloses RDS receive and display.

Ellis et al., U.S. Patent No. 7,343,141 B2. Prior art discloses concurrent broadcast recording.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 3685
July 14, 2009

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